

DISCUSSION OF THE AMENDMENT

Claims 2-9 have each been amended by inserting that the recited derivative is limited to the one having the particular general formula. In addition, Claim 3 has been amended to correct a translation error, as supported in the specification at page 7, first paragraph, page 5, third line from the bottom to page 6, line 2, and page 6, lines 5-10. Claim 6 has also been amended to correct a translation error, which is self-explanatory. In addition, Claims 8 and 9 have been amended by deleting reference to superfluous general formulae and groups.

New Claims 16-21 have been added, and are supported by the claims from which they depend, respectively.

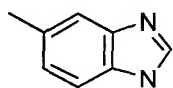
No new matter is believed to have been added by the above amendment. Claims 1-21 are now pending in the application.

REMARKS

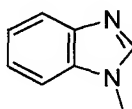
The various rejections of claims as unpatentable over WO 2004/080975 (Yamamoto et al), is respectfully traversed. Yamamoto et al has a prior art date of September 23, 2004, which is the date of its publication. **Submitted herewith** is a certified English translation of Applicants' Japanese priority application JP 2004-112799, filed April 7, 2004.¹ Applicants respectfully request the Examiner to find that Applicants are entitled to their priority date under 35 U.S.C. § 119. Accordingly, Yamamoto et al would be removed as prior art. It is therefore respectfully requested that these rejections be withdrawn.

The rejection of Claims 1-15 under 35 U.S.C. § 103(a) as unpatentable over WO 2003/060956 (Yoon et al), is respectfully traversed.

The presently-claimed invention is drawn to derivatives of heterocyclic compounds having a nitrogen atom containing one or two benzimidazolyl groups represented by the following general formula (A-3) or (A-4) (except that various groups not involved with bonding to the remainder of the derivative have been omitted):



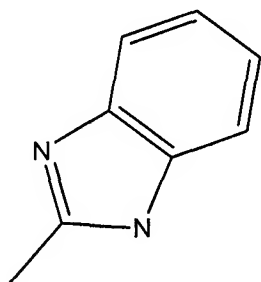
(A-3)



(A-4)

In Yoon et al's compounds, on the other hand, the benzimidazolyl group has the following structure (with analogous omissions of groups, as above):

¹ The certified English translation indicates an error in formulae (A-3) and (A-4) in the priority application. The position of the double bond between a nitrogen and a carbon should have been between the other nitrogen and the carbon. The correct placement is shown, for example, in formulae (1-I) and (1-II) at page 4 and (2-I) and (2-II) at page 5. One skilled in the art would have appreciated that the error was typographical and not substantive.



The Examiner finds that the benzimidazolyl groups of Yoon et al's compounds are connected to an anthracene ring via the 2 position at a carbon, as opposed to the 1 position at a nitrogen, as in general formula (A-4) of the present claims. The Examiner finds that Yoon et al's compound "has conjugation throughout the molecule and would be considered as a structural isomer" to the presently-claimed derivative of general formula (A-1) with (A-4).

In reply, being a structural isomer does not necessarily present a *prima facie* case of obviousness. Indeed, there is no recognition in the art that bonding a benzimidazolyl group through a carbon atom would be expected to behave similarly to bonding such a group through a nitrogen atom. In addition, the specification herein contains comparative data which compares derivatives of the present invention with the various prior art derivatives having benzimidazolyl groups bonded through the same carbon atom as that of Yoon et al, including a compound of Yoon et al (Comparative Example 3). This compound is identical to compound (1-4) of Yoon et al (page 20). This compound is directly comparable to the compound of present Example 2, i.e., compound 1-42. Inventive Compound 1-42 herein differs from Yoon et al's compound of present Comparative Example 3 with respect to where the benzimidazolyl moiety is attached and the placement of the phenyl substituent of the benzimidazolyl moiety. Comparative data is shown in Table 1 at page 120 of the specification showing an increased current density, luminance, and current efficiency for the present invention compared to Yoon et al (and other Comparative Examples having the same

benzimidazolyl moiety as Yoon et al.) Similar results are obtained for Examples 4-6 and 11-13 in which HAr has the general formula (A-3). Such results could not have been predicted from Yoon et al.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 14-15 under 35 U.S.C. § 103(a) as unpatentable over Yoon et al in view of US 6,064,151 (Choong et al), is respectfully traversed.² Choong et al does not remedy any of the above-discussed deficiencies in Yoon et al because Choong et al discloses nothing with regard to a compound having a benzimidazolyl group. Accordingly, it is respectfully requested that this rejection be withdrawn.

The provisional rejection of Claims 1-15 on the ground of nonstatutory double patenting over Claim 1 of copending application 111722609 [sic, 11/722,609], is respectfully traversed. The Examiner is respectfully requested to hold the rejection in abeyance until the present claims are found to be allowable but for this rejection or the copending application has been patented. See M.P.E.P. 822.01.

For all the above reasons, it is respectfully requested that the provisional rejection be held in abeyance, if not withdrawn.

The objection to Claims 8 and 9 is respectfully traversed. Indeed, the objection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

² Choong et al has not been made of record herein. The Examiner is respectfully requested to make Choong et al of record on an appropriate form with the next Office communication.

Application No. 10/594,323
Reply to Office Action of September 3, 2009

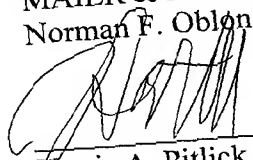
Applicants respectfully submit that all of the presently-pending claims in this application are now in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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